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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,086	06/12/2000	Richard Marc Libman	2176.0010002	6844

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,086

Applicant(s)

LIBMAN, RICHARD MARC

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-211 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-159, 164-166, 168-170, 179, 180, 182, 185-187, 189-190, 194-195, 200-202, 206, 209-210 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 5/22/2006.

Election/Restrictions

2. Newly submitted claims 160-163, 167, 177-178, 181, 183, 188, 191-193, 196, 198-199, 203, 207-208 and 211 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: compliance standards and applicable regulations, predefined events, selecting a second delivery medium for subsequent communication,

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 160-163, 167, 177-178, 181, 183, 188, 191-193, 196, 198-199, 203, 207-208 and 211 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-159, 164-166, 168-170, 179, 180, 182, 185-187, 189-190, 194-195, 197, 200-202, 206, 209-210 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lapa et al. (5,822,735 hereinafter De Lapa).

With respect to claims 1, 53-58, 64, 116-121, 127-131, 143-148, 150-151, 153, 154-159, 164-169, 179, 182, 185-187, 189-190, 194-195, 197, 200-202, 204, 209-210 De Lapa teaches a method of automatically preparing a communication pertaining to a product for an entity (Abstract). (1) Automatically determining whether to offer a product to said entity (figure 6);

(2) if it is determined to offer a product to said entity, then using decision information to automatically determine variable information, the variable information in the communication for said entity (see Figures 2 and 6);

(3) and automatically generating the communication, the communication including an offering to said entity for a product, the communication having communication format, wherein said communication format comprises at least one portion that accommodates the variable information, the generating step including incorporating the variable information into said at least one portion of the communication, wherein the variable information is related to said offering, and wherein the content of said offering in said communication includes variable information such that said offering comprises said variable information in said offering at least partially identifies the product being offered to said entity (see Figure 2).

De Lapa teaches that said variable information may vary among persons being offered said product or said service such that offers of said product to said persons

may vary from person to person (i.e. **assigning different coupon values** to non-customer versus regular customers in order to further induce the customer to the retail store)(in De Lapa, col. 5, lines 14-17 and col. 20, lines 9-12).

DeLapa teaches the steps being performed using data processing devices and within an automated process (i.e. the steps of determining and generating are performed via a computerized system)(see Figure 4).

With respect to the newly added feature of the product/service set includes at least one or more product or services that is at least considered for offering to each entity in said entity ser who is being considered for an offer (i.e. the coupon can be assigned to more than one prior members who is eligible to receive the coupon)(col. 14, lines 33-40)

De Lapa does not specifically teach that the offer is for a financial product or financial service. Official notice is taken that it is old and well known to offer financial products or financial services to customers. For example, bank customers are often offer additional services such as car loans, vacation loans, mortgages loans in order for the banks to provide additional services or products that might be needed by the customers.

With respect to claims 2-11, 65-73 De Lapa further teaches storing said data in one or more databases and collecting additional data from one or more sources, and updating said one or more databases with said additional data accessible via modem (col. col. 7, lines 61-67)

Claims 12-52, 74-115, 132-138, 142, 170, 180 further recite selecting the format for the communication and said selected delivering medium. Official notice is taken that it is well known to select different mediums in which to deliver information to users. For example, some users prefer e-mail to regular mail and this is taken into account in order to select the medium in which to deliver information.

With respect to claims 59-63, 122-126, 139-140, 205-206 the claims further recite that the services relate to mortgage loan, insurance. Official notice is taken that mortgages loans and insurance related products are well known products or services offer to clients in order to meet client's needs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the services or products to be related to mortgage loans and insurance in order to obtain the above mentioned advantages.

With respect to claim 141, De Lapa further teaches providing said communication and reply means to said entity electronically (Figure 5).

With respect to claim 149, 152 De Lapa further teaches selecting a first and second delivering medium that will be used to deliver subsequent communication pertaining to said offer (Figures 1 and 5).

Response to Arguments

4. Applicant argues that DeLapa doesn't teach the product/service set includes at least one or more product or services that is at least considered for offering to each entity in said entity set who is being considered for an offer. The Examiner respectfully disagrees with Applicant because as taught by DeLapa on col. 14, lines 33-40), the same coupon type can be offered to various members who are eligible for the offer. Applicant further argues that once the last coupon is sent to a customer, there is no ability or means to offer such a coupon to a subsequent customer. The Examiner wants to point out that as shown by DeLapa above the same type of coupon can be sent to various members before the coupon is exhausted as long as the subsequent members meet the targeting criteria.
5. Applicant argues that DeLapa doesn't teach offers of any single product or service to said persons can be varied from person to person. The Examiner respectfully disagrees with Applicant because in DeLapa a single type of dog food coupon, can be offered to different customers and based on how frequent or infrequent the customer shops at the establishment, the amount/value of the dog food coupon will vary from person to person (col. 5, lines 11-17). As seen by DeLapa two customers can receive a single product dog food, for example for brand and the value/amount of the same type of product will vary based on the customer's participation.
6. Applicant argues that DeLapa doesn't teach generating the communication for said entity if it is determined to offer said product or service to said entity. The Examiner respectfully disagrees with Applicant because even if DeLapa starts with the

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customer instead of the product, if there is no match for a particular "coupon optional" then a communication containing "optional coupon" will not go out to the customer.

7. Applicant argues that the Examiner hasn't demonstrated how to modify DeLapa in order to incorporate financial products/services. The Examiner disagrees with Applicant because changing one type of product with another type of product doesn't produce a patentable difference.

8. Applicant argues that DeLapa doesn't teach the limitations of claim 9 of modifying the variable information on real-time. The Examiner disagrees with Applicant because in Delapa the information is updated via a processor in real-time.

9. Applicant argues that DeLapa doesn't teach a plurality of mediums. See new rejection above.

10. With respect to the numerous dependent claims, Applicant should incorporate the features that he thinks are novel and non-obvious into the independent claims.

11. The Examiner wants to point out that applicant presents an unreasonable number of claims which are repetitious and multiplied, the net result of which is to confuse rather than to clarify. If Applicant continues with this practice then a rejection on undue multiplicity based on 35 U.S.C. 112, second paragraph, may be appropriate.

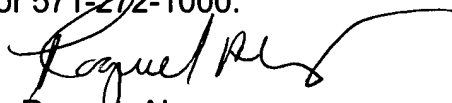
Point of contact

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
8/2/2006

Continuation of Disposition of Claims: Claims withdrawn from consideration are 160-163,167,177,178,181,183,188,191-193,196,198,199,203,207,208 and 211.